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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,799	07/25/2001	Noel Enete	06975-133001	4883
26171 7590 07/03/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER GOLD, AVI M	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/911,799

Applicant(s)

ENETE ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-42, 44-50, 52-62, 64-66 and 68-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-42, 44-50, 52-62, 64-66 and 68-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the RCE amendment filed on April 30, 2007. Claims 43, 51, 63, and 67 were canceled. Claims 78-89 were added. Claims 36, 38, 48, 50, 52, 56-58, 60, 64-66, 68, 69, and 72 were amended. Claims 36-42, 44-50, 52-62, 64-66, and 68-89 are pending.

Response to Amendment

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 36-38, 48-50, 56-58, 64-66, 68-82, and 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone et al., U.S. Patent No. 6,212,548, in view of Ozkan et al., U.S. Patent No. 6,748,421, further in view of Muldoon et al., U.S. Patent No. 7,233,992.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract).

As to claims 36, 56, and 68, DeSimone teaches a communications method, comprising:

establishing a presence-based communications session between a sender and a recipient (col. 1, lines 25-33, col. 4, lines 24-29, DeSimone discloses Internet Relay Chat with a protocol); and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient (col. 5, lines 46-48, col. 15, lines 58-63, DeSimone discloses conversations initiated by the sender and video messages).

generating a video instant message on behalf of the sender (col. 1, lines 45-47, col. 15, lines 58-63, DeSimone discloses video communication through chat and the video sent as an attachment which would be completed by the sender);

storing the video instant message (col. 1, lines 45-47, col. 15, lines 58-63);
and

after generation of the video instant message is completed initiating a transfer of the video instant message to the recipient using the video communications session (col. 5, lines 25-32, DeSimone discloses an instant message being sent from a sender to multiple recipients).

DeSimone fails to teach the limitation further including storing the video instant message on behalf of the sender, after generation of the video instant message is

Art Unit: 2157

complete, receiving an indication to trigger the sending of the message to the recipient, and in response to receiving the indication that triggers sending of the video instant message to the recipient, initiating a transfer.

However, Ozkan teaches a method and system for conveying video messages (see abstract). Ozkan teaches a communication manager storing video data received (col. 13, lines 40-45) and videos being sent when the capture process has stopped (col. 13, lines 9-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Ozkan to store the video instant message on behalf of the sender, after generation of the video instant message is complete, sending of the message to the recipient. One would be motivated to do so because it allows for the completed video to be automatically sent without extra, unnecessary steps from the user.

DeSimone and Ozkan fail to teach receiving an indication to trigger the sending of the message to the recipient, and in response to receiving the indication that triggers sending of the video instant message to the recipient, initiating a transfer.

However, Muldoon teaches a computerized method and system for managing the exchange and distribution of confidential documents (see abstract). Muldoon teaches adding an attachment to email and clicking a send button (col. 7, line 43 – col. 8, line 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone and Ozkan in view of Muldoon to receiving an indication

to trigger the sending of the message to the recipient, and in response to receiving the indication that triggers sending of the video instant message to the recipient, initiating a transfer. One would be motivated to do so because it allows for the user to determine when to send the attachment.

Regarding claims 37, 49, 57, and 65, DeSimone, Okzan, and Muldoon teach the method and computer program of claims 36, 48, 56, and 64 wherein storing the video instant message comprises storing the video instant message in a location that is immutable by the sender (DeSimone, col. 4, lines 46-56, col. 5, lines 25-32).

Regarding claims 38, 50, 58, and 66, DeSimone, Okzan, and Muldoon teach the method and computer program of claims 36, 48, 56, and 64 further comprising, during the presence based communications session between the sender and the recipient, receiving a text instant message intended for the recipient from the sender and delivering the text instant message to the recipient (DeSimone, col. 4, lines 46-56, col. 5, lines 25-32).

As to claims 48, 64, and 69, DeSimone teaches a communications method, comprising:

establishing a presence-based communications session between a sender and a recipient (col. 1, lines 25-33, col. 4, lines 24-29); and

during the presence-based communications session between the sender and the recipient:

establishing a video communications session between the sender and the recipient (col. 5, lines 46-48, col. 15, lines 58-63, DeSimone discloses conversations initiated by the sender and video messages).

receiving, on behalf of the recipient, a video instant message sent by the sender using the video communications session (col. 1, lines 25-33, col. 4, lines 24-29, col. 5, lines 25-32);

storing the video instant message (col. 1, lines 45-47, col. 15, lines 58-63);
accessing the video instant message (col. 4, lines 46-56, DeSimone discloses messages sent to a server); and

enabling presentation of the video instant message to the recipient (col. 4, lines 46-56, col. 5, lines 25-32).

DeSimone fails to teach the limitation further including receiving, on behalf of the recipient, a completed video instant message sent by the sender using the video communications session and storing the video instant message on behalf of the recipient.

However, Ozkan teaches videos being sent when the capture process has stopped (col. 13, lines 9-35) and a communication manager storing video data received (col. 13, lines 40-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone in view of Ozkan to receive, on behalf of the recipient, a

Art Unit: 2157

completed video instant message sent by the sender using the video communications session and store the video instant message on behalf of the recipient. One would be motivated to do so because it allows for the completed video to be automatically sent without extra, unnecessary steps from the user.

DeSimone and Ozkan fail to teach a video instant message sent by the sender.

However, Muldoon teaches adding an attachment to email and clicking a send button (col. 7, line 43 – col. 8, line 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone and Ozkan in view of Muldoon to have a video instant message sent by the sender. One would be motivated to do so because it allows for the user to determine when to send the attachment.

Regarding claims 70, 72, 74, and 76, DeSimone, Okzan, and Muldoon teach the method and system of claims 36, 48, 68, and 69, wherein generating the video instant message with a client device comprising a processor, a controller and a storage medium (col. 10, lines 30-47, Ozkan discloses a video capture device).

Regarding claims 71, 73, 75, and 77, DeSimone, Okzan, and Muldoon teach the method and system of claims 70, 72, 74, and 76, wherein the client device comprises a set-top box (col. 10, lines 30-47, Ozkan discloses a visual and audio sensor system).

Regarding claim 78, DeSimone, Okzan, and Muldoon teach the method of claim 36 wherein establishing a presence-based communications session between a sender and a recipient comprises establishing an instant messaging communications session between a sender and a recipient (DeSimone, col. 5, lines 46-48, col. 15, lines 58-63).

Regarding claim 79, DeSimone, Okzan, and Muldoon teach the method of claim 36 wherein the presence-based communications session requires that both the sender and the recipient are accessing a communications infrastructure over which the presence-based communications session is established at the same time such that establishing the presence-based communications session between the sender and the recipient comprises establishing the presence-based communications session between the sender and the recipient over the communications infrastructure when the sender and the recipient are both accessing the communications infrastructure at the same time (DeSimone, col. 4, lines 46-56, col. 5, lines 25-48, col. 15, lines 58-63).

Regarding claim 80, DeSimone, Okzan, and Muldoon teach the method of claim 36 wherein establishing a presence-based communications session between a sender and a recipient comprises:

establishing a persistent connection between the sender and the recipient; and
establishing the communications session over the persistent connection between the sender and the recipient (DeSimone, col. 4, lines 46-56, col. 5, lines 25-48, col. 15, lines 58-63).

Regarding claim 81, DeSimone, Okzan, and Muldoon teach the method of claim 36 wherein establishing a video communications session between the sender and the recipient is conditioned upon having previously established the presence-based communications session between the sender and the recipient (DeSimone, col. 5, lines 46-48, col. 15, lines 58-63).

Claims 82 and 85-87 do not teach or define any new limitations above claims 36-38 and therefore are rejected for similar reasons.

3. Claims 39-42 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon further in view of Doty, Jr., U.S. Patent No. 6,795,863.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract). Ozkan teaches the invention substantially as claimed including a method and system for conveying video messages (see abstract). Muldoon teaches the invention substantially as claimed including a computerized method and system for managing the exchange and distribution of confidential documents (see abstract).

As to claims 39-42 and 59-62, DeSimone, Ozkan, and Muldoon teach the method and computer program of claims 36 and 56.

DeSimone, Ozkan, and Muldoon fail to teach the limitation further including accessing an indication of capabilities of the recipient, identifying hardware and software associated with the recipient, and displaying a user interface according to the capabilities of the recipient.

However, Doty, Jr. teaches a plurality of client recipient computers, wherein the video streams may be embedded into a web page that provides e-mail services, preferably over the Internet (see abstract). Doty, Jr. teaches the use of a recipient computer specifying its hardware and software capabilities (col. 8, lines 45-50) and a product distribution smart server basing its data stream format on recipient capabilities (col. 8, lines 54-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone, Ozkan, and Muldoon in view of Doty, Jr. to access an indication of capabilities of the recipient, identify hardware and software associated with the recipient, and displaying a user interface according to the capabilities of the recipient. One would be motivated to do so because it would allow for the recipient to view the video communication at the best possible quality and to avoid errors in viewing.

4. Claims 44-47 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon further in view of Wan et al., U.S. Patent No. 6,529,475.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract). Ozkan teaches the invention substantially as claimed including a method and system for conveying video messages (see abstract). Muldoon teaches the invention substantially as claimed including a computerized method and system for managing the exchange and distribution of confidential documents (see abstract).

As to claims 44-47 and 52-55, DeSimone, Ozkan, and Muldoon teach the method of claims 36 and 48.

DeSimone, Ozkan, and Muldoon fail to teach the limitation further including the video communication comprising establishing a generic signaling interface channel, a control channel, and a video channel between the sender and the recipient, the control channel comprising a TCP/IP socket, the video channel comprising a UDP channel, and the video channel comprising a TCP channel.

However, Wan teaches a method and system for improving flow of data traffic within a multimedia communications network by reducing congestion (see abstract). Wan teaches the use of a signaling channel, control channel, and data channel through which video is sent and TCP for the video and control channel (col. 3, lines 24-30) and UDP for the video (col. 3, lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone, Ozkan, and Muldoon in view of Wan to use a generic

Art Unit: 2157

signaling interface channel, a control channel, and a video channel between the sender and the recipient, the control channel comprising a TCP/IP socket, the video channel comprising a UDP channel, and the video channel comprising a TCP channel. One would be motivated to do so because a UDP channel minimizes latency and a TCP channel is used to pass through firewalls that block UDP.

5. Claims 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone, Ozkan, and Muldoon further in view of Cleron et al., U.S. Patent No. 6,223,213.

DeSimone teaches the invention substantially as claimed including systems and methods for establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions (see abstract). Ozkan teaches the invention substantially as claimed including a method and system for conveying video messages (see abstract). Muldoon teaches the invention substantially as claimed including a computerized method and system for managing the exchange and distribution of confidential documents (see abstract).

As to claims 83 and 84, DeSimone, Ozkan, and Muldoon teach the method of claim 79.

DeSimone, Ozkan, and Muldoon fail to teach the limitation further including the use of a hyperlink that is selectable by the recipient to trigger a transfer of the video instant message.

However, Cleron teaches a browser-based email system with user interface for audio/video capture (see abstract). Cleron teaches the use of a token, which could be a hyperlink, sent in an email that is representative of the attached clip (col. 7, lines 14-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify DeSimone, Ozkan, and Muldoon in view of Cleron to use a hyperlink that is selectable by the recipient to trigger a transfer of the video instant message. One would be motivated to do so because it allows for the recipient to choose when to view the video.

Response to Arguments

6. Applicant's arguments with respect to claims 36-77 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments regarding the combination of DeSimone and Ozkan, filed April 11, 2007, have been fully considered but they are not persuasive.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 2157

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art.

10. In response to applicant's argument that Ozkan is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Ozkan is related to the delivery of video.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,677,976 to Parker et al.

U.S. Pat. No. 6,564,248 to Budge et al.

U.S. Pat. No. 5,956,716 to Kenner et al.

U.S. Pat. No. 5,793,365 to Tang et al.

U.S. Pat. No. 5,764,916 to Busey et al.

U.S. Pat. No. 6,738,822 to Fukasawa et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

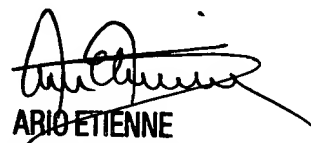
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Avi Gold

Patent Examiner

Art Unit 2157

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